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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,177	07/31/2003	Renee M. Kovales	RSW920000128US2	9830

25259 7590 03/29/2006

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EXAMINER	
PATEL, HEMANT SHANTILAL	
ART UNIT	**PAPER NUMBER**
2614	

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/632,177	KOVALES ET AL.	
	Examiner	Art Unit	
	Hemant Patel	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5-12,14-18,20-24,28,34,37,43,46,67,68 and 89-95* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5-12,14-18,20-24,28,34,37,43,46,67,68 and 89-95* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Invention 1: Claims 1, 2, 5-12, 14-18, 20-24, 28, 34, 37, 67-68, 89-90, 92-93 drawn to Voice Mail, classified in class 379, subclass 88.13.

   II. Invention 2: Claims 46, 94-95 drawn to Two Party Call, classified in class 379, subclass 101.01.

   III. Invention 3: Claims 43, 91 drawn to Marketing, classified in class 705.

2. Inventions 1 and 2 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination 1 has separate utility such as voice mail system and method. Invention 2 is related to two party conversations. See MPEP § 806.05(d).

3. Inventions 1 and 3 are directed to related products. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, invention 1 is related to voice mail system and method. Invention 2 is related to marketing.

4. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with attorney of record, Bruce Clay on March 2, 2006 a provisional election was made without traverse to prosecute the invention of 10/632,177, Claims 1, 2, 5-12, 14-18, 20-24, 28, 34, 37, 67-68, 89-90, 92-93. Affirmation of this election must be made by applicant in replying to this Office action. Claims 43, 46, 91, 94-95 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

1. The disclosure is objected to because of the following informalities: The specification does not indicate Patent Number for parent.

Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 2, 5-12, 14-18, 20-24, 28, 34, 37, 67-68, 89-90, 92-93 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of Kovales, Parent U.S. Patent No. 7,003,083 (hereinafter referred to as ,083) in view of Ball (US Patent No. 6,459,774 B1 hereinafter referred to as ,774).

Regarding claims 1, 34, The claim 1 of Parent US Patent ,083 teach of storage of voicemail message with associated background sounds as claimed by claims 1 and 34 of instant application. The claim 1 of Parent US Patent ,083 further teaches of the purpose of the voice mail as playing back to a listener.

The claim 1 of Parent US Patent ,083 does not teach of requesting for and playing back the voice mail to the listener.

However, in the same field of endeavor, Ball teaches of storage of voicemail message with associated background sounds and playing back this voicemail by incorporating the associated background sounds when requested by the user.

It would have been obvious to a person of ordinary skill in the art to modify US Patent ,083 claim 1 by adding the function of playing back the voicemail message with associated background sound incorporated with it as taught by Ball and also as described in Parent US Patent ,083.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-2, 5-9, 18, 22, 34, 67, 89, 93 are rejected under 35 U.S.C. 102(e) as being anticipated by Ball (US Patent No. 6,459,774 B1).

a. ***Regarding claim 1,*** Ball teaches of a method of enhancing voice mail messages for playback to a listener, further comprising steps of:

storing a voice mail message (col. 4, ll. 44-48);

separately storing a background sound that has been selected for incorporating with the voice mail message (col. 8, ll. 9, 40, inspirational music played in background and it is stored as audio file separate from the message);

responsive to a request from the listener for playback of the stored voice mail message, incorporating the separately-stored background sound with the stored voice mail message (col. 4, ll. 47-48; user accessing his mailbox); and

playing back a result of the incorporating step (col. 8, ll. 34-44).

Regarding claim 2, Ball further teaches of storing the voice mail message as a plurality of message segments (Fig. 10, item 1012) and background sounds are stored separately and accessed with their file names (col. 8, Table 1) and these are incorporated before playing to the recipient (col. 8, ll. 34-44).

Regarding claim 5, Ball further teaches of theme song (col. 8, ll. 9, 40, inspirational music) associated with the speaker leaving the message.

Regarding claims 6, 7, Ball further teaches of audio files (col., 8, Table 1, "from.au", "for.au", "thanks.au", "course.au") selected by the user for inserting in the voice mail message, these audio files are stored separately from the message, they can be placed (referenced) in any sequence in the message (col. 8, Table 1) and their position in the message associates them to their respective message segments, and all these parts are assembled together by the integrated messaging system (Fig. 9, item 104) at the time of playback to the recipient (col.8, ll. 34-52).

Regarding claim 8, Ball further teaches of speaker of the voice mail message explicitly selecting audio files.

Regarding claim 9, Ball further teaches of selecting background sound programmatically (col. 8, ll. 9, by programming in PML providing file name as parameter of <AUDIO SRC> tag), based on a speaker-specific (each user makes his/her own selection), device-independent identifier (file name provided is the same i.e. with .au file type for audio, whether it is located locally or located remotely with a URL link, and also it can be done either using display with GUI or using plain text editor, col. 27, ll. 53-55, col. 28, ll. 31-32) provided by a speaker of the voice mail message.

Regarding claim 18, Ball further teaches of speaker dynamically selecting audio files as he needs them and these files are stored in integrated messaging system (Figs. 9, 10, col. 8, Table 1).

Regarding claim 22, Ball further teaches of using identifier to locate and retrieve associated data (col. 26, ll. 63-66, i.e. similarly identifier can be used to locate and select sound files).

Regarding claim 34, Ball further teaches of storing the voice mail message as a plurality of message segments (Fig. 10, item 1012) and selected audio files are stored separately and accessed with their file names (col. 8, Table 1) and they can be placed (referenced) in any sequence in the message (col. 8, Table 1) and their position in the message associates them to their respective message segments, and all these parts are assembled together by the integrated messaging system (Fig. 9, item 104) at the time of playback to the recipient (col.8, ll. 34-52).

Regarding claim 67, Ball teaches of a system of enhancing voice mail messages, comprising:

means for storing a plurality of voice mail messages, each message comprising one or more message segments (col. 4, ll. 44-48, col. 5, ll. 44-48);

means for associating, with individual ones of the stored voice mail messages, zero or more audio files (col. 8, Table 1); and

means for enabling listener to preview the stored voice mail messages by selectively playing back one or more of the audio files associated therewith (col. 11, ll. 66-col. 12, ll. 27).

Regarding claim 89, Ball further teaches of inserting command or input using keypad entry during message play-out to select link or provide information (col. 27, ll. 47-52).

Regarding claim 93, Ball further teaches of using <PROMPT> and <TITLE> element tags to prompt the listener to make a choice, thereby making it possible to include <AUDIO SRC = "background sound file name" BAKCGROUND/> as part of

prompt selection to turn the background sound On/Off as per listener selection (col. 11, ll. 39-53).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ball as applied to claim 1 above, and further in view of Hsu (US Patent No. 5,860,065).

Regarding claim 10, Ball teaches of enabling a speaker of the voice mail message to explicitly select the background sound (Fig. 10, item 1012, col. 8, Table 1).

Ball does not teach of selecting a default background.

However, in the same field of endeavor, Hsu teaches of automatically inserting background music without user selection (Abstract, ll. 1-4, col. 1, ll. 44-48).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ball to include automatic (default) background insertion as taught by Hsu in order to save time and effort for the user.

4. Claims 12, 16, 17, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball as applied to claim 1, 2 above, and further in view of Yi (US Patent No. 6,407,325 B2).

Regarding claim 12, Ball teaches of selecting background sound programmatically (col. 8, ll. 9, by programming in PML providing file name as parameter of <AUDIO SRC> tag) from among plurality of background sounds.

Ball does not teach of selecting it from background sounds on a telephone device.

However, in the same field of endeavor, Yi teaches of storing digital music files on telephone device (Abstract, ll. 6-7, Fig. 2, item 211, col. 3, ll. 21-22).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ball to include digital music files on a telephone device as taught by Yi in order to enable user to easily update the selection of available background music.

Regarding claim 16, Ball does not teach of selecting background sound based on the identification of the recipient.

However, in the same field of endeavor, Yi teaches of selecting background sound based on the identification of dialed phone number (Abstract, ll. 17-20, Fig. 4, steps 403, 404, col. 5, ll. 26-29).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ball to include selecting background music as per dialed number as taught by Yi in order to enable user to provide customized differentiated experience to his/her contact.

Regarding claim 17, Yi further teaches of selecting background sound configured on a telephone device (device-specific) from which communication originates (Abstract).

Regarding claim 20, Yi further teaches of transmitting selecting background sound from a telephone device (device-specific) used by the speaker (Abstract).

5. Claims 11, 15, 28, 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball as applied to claim 1 above, and further in view of Goldberg (US Patent No. 6,125,175).

Regarding claim 11, Ball does not teach selecting background sound based on date.

However, in the same field of endeavor, Goldberg teaches of inserting background sound based on time frame (date) (col. 4, ll. 48-49).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ball to provide selective background sounds based on time frame as taught by Goldberg in order to enable the user to preset background music for relatives and friends birthdays.

Regarding claim 15, Ball does not teach of selecting background sound using the profile of a speaker.

However, in the same field of endeavor, Goldberg teaches of selecting background sound using the ANI of a speaker suggesting speaker specific preference (profile) and is selected without speaker's intervention (col. 5, ll. 16-18).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ball to include selecting speaker specific background music without speaker intervention as taught by Goldberg in order to enable the automatic insertion of background music in preselected calls (Goldberg, col. 5, ll. 17).

Regarding claim 28, Goldberg further teaches of using DTMF (phone keypad) to make selection and provide input (col. 4, ll. 20-22, 28).

Regarding claim 92, Goldberg further teaches of programmatically selecting background sound based on set of rules established (col. 4, ll. 53-57, selecting background sound based on preset rules for keypad button pressed, voice recognition for specific spoken word or words).

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ball as applied to claim 1 above, and further in view of Ogawa (US Patent No. 6,634,992 B1).

Regarding claim 14, Ball does not teach of selecting background sound randomly.

However, in the similar field of communicating, Ogawa teaches of selecting stored image data randomly (col. 30, ll. 6-8).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ball to include random selection of data as taught by Ogawa so that "This gimmick, which prevents the display of the same image all the time, can help keep the exerciser interested in the exercise" (Ogawa, col. 30, ll. 8-10).

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ball and Yi as applied to claim 20 above, and further in view of Newton (Newton's Telecom Dictionary, 16th edition, ISBN # 1-57820-053-9).

Regarding claim 21, Ball does not teach of sound compression before transmitting.

However, in the same field of endeavor, Newton teaches of compression of information representation (Pg. 204).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ball to include information (sound) compression as taught by Newton in order to save transmission time, capacity and storage space (Newton).

8. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball as applied to claim 1, 2 above, and further in view of Hinde (US Patent Application Publication NO. 2002/0082838 A1).

Regarding claims 23, 24, Ball does not teach of transmitting address from telephone device.

However, in the same field of endeavor, Hinde teaches of sending URL address from the terminal to locate the contact data of the voice service (Paragraph 0071, 0077).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ball to include sending URL address as taught by Hinde in order to "retrieve a first page of the voice service associated with the plant" (Hinde, Paragraph 0071).

9. Claims 37, 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball as applied to claim 34 above, and further in view of Tang (US Patent No. 6,532,477 B1).

Regarding claim 37, Ball does not teach of audio signature.

However, in the same field of endeavor, Tang teaches of using audio signature to identify data items (email, telephone calls etc.) with their sources (col. 1, ll. 59-col. 2, ll. 50).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ball to use audio signature as taught by Tang in order to enable the "user to associate the audio signature with the source from which the data item originated" (Tang, col. 2, ll. 4-6).

Regarding claim 68, Ball teaches of selectively previewing the segments of the stored messages (col. 11, ll. 66-col. 12, ll. 27).

Ball does not teach of audio signature.

However, in the same field of endeavor, Tang teaches of using audio signature to identify data items (email, telephone calls etc.) with their sources (col. 1, ll. 59-col. 2, ll. 50).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ball to include audio signature and use it as taught by Tang in order to allow the selective preview of audio signature segment of messages to identify the source of message origination (Tang, col. 2, ll. 4-6).

10. Claim 90 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ball and Yi as applied to claim 20 above, and further in view of Satou (US Patent No. 5,850,431).

Regarding claim 90, Ball and Yi do not teach of extending call after finishing messaging.

However, in the same field of communication, Satou teaches of user finishing voice communication (col. 8, ll. 52-55, similar to finishing messaging) after instruction to send facsimile (col. 8, 27-32, similar to start sending background audio) causing the extension of call for transmission of facsimile data (col. 8, ll. 32-49), ending the call when the facsimile transmission ends (col. 8, ll. 55-58) and the user is on-hook.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ball and Yi to allow call continuation of transmission of data even after user has finished voice communication and has gone on-hook as taught by Satou in order to enable the user to selectively end or continue voice call after transmission (Satou, col. 8, ll. 55-58).

Conclusion

Chan (US Patent No. 6,870,807 B1) Method And Apparatus For Suppressing Music On Hold

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant Patel whose telephone number is 571-272-8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hemant Patel
Examiner
Art Unit 2645

HSP

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